

## REMARKS

By the above amendment, claims 7, 8 and 20, as amended by the Amendment of December 17, 2003, have been reamended to correspond to the claims as presented in the Amendment of July 16, 2003 in accordance with the position taken by the Examiner.

In paragraph 1(a) of the present Office Action, the Examiner states "...the Final Rejection (paper 13) on September 24, 2003 is withdrawn." (emphasis added).

In paragraph 1(b) at page 2 of the present Office Action, the Examiner states:

The amendment filed on December 17, 2003 is not entered and the following rejection is based on the Amendment filed on July 16, 2003 (paper 12). (emphasis added)

Applicants submit that the Examiner's non-entry of the Amendment filed on December 17, 2003 is not understood and contrary to the procedures of the U.S. Patent and Trademark Office. More particularly, reference is made to MPEP §706.07(e) which provides, *inter alia*:

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered. (emphasis added)

Applicants therefore submit that the Amendment of December 17, 2003 is properly entered in this application, and the Examiner has not set forth any legal basis or authority to deny entry thereof. Applicants note that should the Examiner continue to suggest that the Amendment of December 17, 2002 is not entered, a Petition lies from this action by the Examiner.

Since applicants submit that the Amendment of December 17, 2003 is properly entered in this application and the Examiner has indicated in paragraph 1(b) at page 2 of the present Office Action that "the following rejection is based on the Amendment filed on July 16, 2003 (paper 12)", it is apparent that the present Office Action of January 23, 2004 does not relate to the claimed invention as presented by the Amendment of December 17, 2003, and therefore, the Office Action of January

23, 2004 is incomplete with the finality thereof being premature since the Office Action of January 23, 2004 does not relate to the invention as claimed. Applicants submit that the Examiner cannot ignore limitations of the claims present in this application by indicating non-entry of the Amendment of December 17, 2003, which automatically became entered upon withdrawal of the finality of the prior Office Action. Should the Examiner again insist that the Office Action of January 23, 2004 is a complete Office Action and the finality thereof is proper, applicants note that although applicants have requested withdrawal of the finality and a complete Office Action directed to the claimed invention as set forth in the Amendment of December 17, 2003, a Petition lies from the Examiner's action.

In order to provide a full response to the improper rejection as set forth in the Office Action of January 23, 2004, which rejection is not directed to the claims as presented in the Amendment of December 17, 2003, but apparently is directed to the claims as presented by this Amendment, applicants traverse the rejection of claims 7, 9-16, 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over Fuji (U.S. Patent 6,310,846) in view of Lee (U.S. Patent 5,241,524) as being improper for the reasons as presented in the amendments of December 17, 2003 and July 26, 2003, and submit that additionally, the rejection necessarily fails in that Fuji (U.S. Patent 6,310,846) is not properly utilizable in rejecting claims of this application.

Applicants note that Fuji has a U.S. filing date of November 12, 1998 which is subsequent to the filing date in Japan of Japanese application No. 10-220097, filed August 4, 1998 and Japanese application No. 10-246744, filed September 1, 1998, for which priority has been claimed in this application with certified copies of the priority documents being submitted in parent application Serial No. 09/366,641, now U.S. Patent No. 6,160,784, on September 15, 1999.

In accordance with the procedures set forth in MPEP §201.15, submitted herewith is a Verified English Translation of Japanese patent application No. 10-220097 and a Verified English Translation of Japanese patent application No. 10-

246744, for which priority has been claimed in the present application, which Japanese applications have filing dates in Japan of August 4, 1998 and September 1, 1998, respectively, which dates are prior to the U.S. filing date of November 12, 1998 of Fuji. Thus, applicants submit that Fuji is not properly utilizable in rejecting claims of this application, and the rejection under 35 U.S.C. 103 based upon the combination of Fuji and Lee is necessarily overcome. Thus, further discussion with respect to the inapplicability of Fuji to the claimed invention is considered unnecessary.

Turning to Lee, applicants note that Lee, taken alone, fails to disclose or teach the claimed features as set forth in the claims of this application. Applicants note that independent claim 7 recites specific features of the recording medium indicating the feature of a lookup table which stores information about edge shifting values of an edge of a recording pulse to be determined by combinations of either a mark length and another mark length immediately precedent to the mark length or a mark length and another mark length immediately subsequent to the mark length, and independent claim 8 recites other features of the lookup table which stores information of edge shifting values for recording a mark  $3T_w$  long, where  $T_w$  is a time width. This realizes a stable recording with consideration of thermal interference even in high density recording, referring to the description at page 13, line 25 to page 14, line 4 of the specification of this application. More specifically, a problem of the thermal interference rises at the time of recording information, but for a purpose of reducing thermal interference affection, the edge is shifted in accordance with a space length of either immediately precedent to the mark or subsequent to the mark.

In contrast to the present invention, Lee discloses a lookup table as shown in Figs. 6-8 thereof, in which a relationship between the channel bits and recording pulse data (including the number of writing pulses, pulse width and first and second pulse intervals) are recorded, referring to col. 7m, lines 53-64. Specifically, the lookup table of Lee records the relationship between the channel bit stream and

recording waveforms or pulses. In the case of Lee, the pulse width data are recorded in the lookup table, but this lookup table of Lee does not record the combinations of either a mark length and another mark length immediately precedent to the mark length or a mark length and another mark length immediately subsequent to the mark length, as recited in claim 7 and the dependent claims or information of edge shifting values for recording a mark  $3T_w$  long, where  $T_w$  is a time width as recited in independent claim 8 and the dependent claims, nor the other features of the independent and dependent claims of this application. Moreover, Lee does not suggest the reduction of thermal interference, consequently, it cannot obtain the feature of reducing the thermal interference and realize stable recording, as obtained with the present invention.

Therefore, applicants submit that Lee, taken alone, fails to provide the claimed features of the claims of this application and all claims patentably distinguish thereover in the sense of 35 U.S.C. 103.

In view of the above amendments and remarks, applicants submit that all claims present in this application, as appearing in the listing of the claims to this response, representing claims amended by the Amendment of December 17, 2003, should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.37445CX1) and please credit any excess fees to such deposit account.

Respectfully submitted,



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